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Katsushi Horihata

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EXAMINER

RILEY, MARCUS T

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/823,334

Applicant(s)

HORIHATA, KATSUSHI

Examiner

Marcus T. Riley

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/12/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/12/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>attached</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claim 14** is rejected under 35 U.S.C. 102(e) as being anticipated by Gacek (US 6,795,205 B1 hereinafter, Gacek '205).

**Regarding claim 14;** Gacek '205 discloses an image forming apparatus which is so configured as to receive print data from a server via the Internet for printout of the print data, the apparatus comprising: (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer*

*being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing.*" column 3, lines 52-63): an inputting unit that allows a user to input a document ID used in verifying that receiving of print data is permitted (*"If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320."* column 11, lines 66-67 thru column 12, lines 1-6); a sending unit that sends the document ID inputted to the inputting unit to the server (*"If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320."* column 11, lines 66-67 thru column 12, lines 1-6); a receiving unit that receives print data identified by the document ID sent from the sending unit (*"As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within*

*CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.” column 7, lines 47-62); an accounting data including information relating to a payer which is determined based on the document ID (“Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer.” column 4, lines 31-36); an outputting unit that outputs the print data received by the receiving unit (“By virtue of this arrangement, a mechanism is provided whereby third-party-initiated print jobs to a specific home user can be blocked unless compensation is provided by the initiating third party for the ink and paper used to print the print job.” column 4, lines 66-67 thru column 5 lines 1-4); and a fee collecting unit that collects a certain fee from a print data recipient if the print data recipient is determined as the payer based on the accounting data received by the receiving unit (“Preferably, intermediary services 305 and 315 utilize secure connections over internet 301 so that negotiations for authorization to push a print job, instructions to allow the print job to reach the home user's printer, and payment collection and transfer to the home user are conducted in a*

*secure manner. Intermediary services 305 and 315 therefore provide each home user with the ability to control which print jobs are allowed to be push -printed to the home user's printer, if any, and the ability to be compensated for those print jobs which the home user allows."* column 10, lines 29-38).

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-5, 8-10 & 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gacek '205 in combination with Lewis et al. (US 6,233,565 B1 hereinafter, Lewis '565).

**Regarding claim 1;** Gacek '205 discloses a wide area network printing system which is so configured that, in response to receiving print data from a contents server providing various information including the print data, a document server sends the print data to an image forming apparatus which is installed remotely away from the document server but is communicatively connected therewith via the Internet for printout, wherein: the image forming apparatus comprises: ("*...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via*

*the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing.” column 3, lines 52-63); an accepting unit that accepts input of a document ID used in verifying that receiving of print data is permitted (“If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320.” column 11, lines 66-67 thru column 12, lines 1-6); a sending unit that sends the document ID inputted into the accepting unit to the document server (“If third-party merchant 302 successfully negotiates with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to step S406 in which intermediary service 305 contacts CHE 311 of digital cable network 306 and instructs CPSI server 312 to accept the print job when it is subsequently sent to CHE 311 for being forwarded over digital cable network 306 to home user 320.” column 11, lines 66-67 thru column 12, lines 1-6); a receiving unit that receives print data from the document server (“The aforementioned token is preferably sent along with the print job by third-party merchant 302 to CPSI server 312, whereupon the token is inspected by CPSI server 312 and, if found to be authentic, is used by CPSI server 312 in conjunction with the previously received instructions to determine whether to accept the print job for home user 320. CHE 311 then processes, spools and de-spools the print job, and sends the print job to STB 322 of home user 320.” column 12, lines 52-60); an outputting unit that outputs the print data (“By virtue of this arrangement, a mechanism is*

*provided whereby third-party-initiated print jobs to a specific home user can be blocked unless compensation is provided by the initiating third party for the ink and paper used to print the print job.” column 4, lines 66-67 thru column 5 lines 1-4);*

and the document server comprises: a storing unit that stores the print data sent from the contents server, and the document ID in association with the print data therein (*“Preferably, CPSI server 312 controls access to printers of home users by accepting a print job addressed to a home user only if the print job is specifically allowed according to the preferences of the home user which are stored in preferences directory 21, or if CPSI server 312 has been instructed by an authenticated intermediary service to accept the print job.” column 12, lines 13-19);* a print data retrieving unit that retrieves, from the storing unit, the print data identified by the document ID sent from the sending unit (*“As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.” column 7, lines 47-62)* an accounting unit that calculates a fee relating to printout of the print data retrieved by the print data retrieving unit (*“A payment amount is negotiated between the intermediary service and the*



*internet application for the authorization to transmit the print data. Authorization is provided from the intermediary service to the internet application to transmit the print data to the home access device via the print server. A notification is sent from the intermediary service to the print server that the intermediary has authorized the internet application to transmit the print data to the home access device. The print data is then transmitted from the internet application to the home access device via the print server for printing on the printer.” column 4, lines 21-31);* Gacek ‘205 discloses a payer judging unit that judges a payer of the fee relating to printout of the print data, based on the document ID (*“Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer.” column 4, lines 31-36);* a data sending unit that sends the print data and the accounting data to the receiving unit of the image forming apparatus (*“In particular, third-party merchant 102 sends a print job representing a financial statement via internet 101 and digital cable network 105 to the set-top box of home user 115 for printing on a printer of home user 115. This is referred to as "push -printing".” column 6, lines 54-59);* a controlling unit that controls the data sending unit to send, to the receiving unit of the image forming apparatus, the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the receiving unit of the image forming apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges

that the print data provider is the payer ( "...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing on the printer. Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer. By virtue of this arrangement, a method is provided whereby third-party-initiated print jobs to a specific home user can be blocked unless payment is provided by the initiating third party to compensate the home user for the ink and paper used during printing of the print job. In another embodiment of the invention, a method is provided for authorized transmission of print data from an internet application residing on a first network to a home access device residing on a second network, the home access device having a printer connected thereto, the second network having a print server which interfaces the first network to the second network and which controls data transmission to the home access device. Print data is generated by the internet application and an intermediary service is contacted to obtain authorization for the internet application to transmit the print data to the home access device via

*the print server. A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data.” column 3, lines 52-67 thru column 4, lines 1-22); where the image forming apparatus further comprising fee collecting unit that collects the fee from the print data recipient in the case where the receiving unit of the image forming apparatus receives, from the data sending unit of the document server, the accounting data indicating that the print data recipient is the payer (“Preferably, intermediary services 305 and 315 utilize secure connections over internet 301 so that negotiations for authorization to push a print job, instructions to allow the print job to reach the home user's printer, and payment collection and transfer to the home user are conducted in a secure manner. Intermediary services 305 and 315 therefore provide each home user with the ability to control which print jobs are allowed to be push -printed to the home user's printer, if any, and the ability to be compensated for those print jobs which the home user allows.” column 10, lines 29-38).*

Gacek '205 does not expressly disclose storing the fee as accounting data.

Lewis '565 discloses and storing the fee as accounting data (“*Electronic payments are reported to the transaction server 180 which then transmits them to a specified financial institution for deposit. Upon receipt back of an authorization code, transaction server 180 then increments the user's descending register 21 in PSC 20n with the correct amount. The ascending and descending registers of each user 2n are stored on the Master Server 300 at RSP 4. Under current Postal Service guidelines, the total maximum amount permitted in the descending register 21 is \$500.00, but any value could be used, as well as no limit at all.*” column 12, lines 21-30).

Gacek '205 and Lewis '565 are combinable because they are from same field of endeavor of network systems (*"The server has a network including a transaction server, a transaction database, a server authentication module, and a receipt generation module. An internet connection is used between the client and the server network."* Lewis '565, See "Abstract").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network system as taught by Gacek '205 by adding a storing the fee as accounting data as taught by Lewis '565.

The motivation for doing so would have been because it would be advantageous to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (*"It is another object of the invention to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (e.g., increased efficiency in scheduling and delivery of packages and mail in electronic commerce that is secure and traceable)."* Lewis '565 at column 2, lines 11-14).

Therefore, it would have been obvious to combine Gacek '205 with Lewis '565 to obtain the invention as specified in claim 1.

**Regarding claim 2;** Gacek '205 discloses wherein at least one of the document server and the contents server further comprises a client data storing unit that stores data relating to clients therein, and the payer judging unit judges whether charging is necessary based on the client data (*"It can be appreciated that several different means can be utilized to tender the payment. For instance, third-party merchant may have a pre-existing account with intermediary service 305, whereupon the account is simply debited the amount of the payment. Instead, the payment could be directly billed by intermediary service 305 to third-party merchant 302. In*

*another example, third-party merchant 302 may present credit card information to intermediary service 305 which is then verified and charged according to commonly known internet credit card techniques and services.” column 14, lines 22-32).*

**Regarding claim 3;** Gacek ‘205 discloses wherein at least one of the document server and the contents server further comprises print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data (*“Preferably, CPSI server 312 controls access to printers of home users by accepting a print job addressed to a home user only if the print job is specifically allowed according to the preferences of the home user which are stored in preferences directory 21, or if CPSI server 312 has been instructed by an authenticated intermediary service to accept the print job. In the latter case, CPSI server 312 preferably allows acceptance of the authorized print job for only a limited amount of time from the receipt of the authenticated intermediary service's instructions, after which the print job will not be accepted by CPSI server 312. If third-party merchant 302 does not successfully negotiate with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to end (step S412) and the process is terminated.”* column 12, lines 13-27).

**Regarding claim 4;** Gacek ‘205 discloses wherein the controlling unit of the document server restricts the number of transmissions of the print data identified by the document ID to the image forming apparatus when the document server receives the document ID from the image forming apparatus two or more number of times (*“In another embodiment of the invention, a*

*method is provided for authorized transmission of print data from an internet application residing on a first network to a home access device residing on a second network, the home access device having a printer connected thereto, the second network having a print server which interfaces the first network to the second network and which controls data transmission to the home access device. Print data is generated by the internet application and an intermediary service is contacted to obtain authorization for the internet application to transmit the print data to the home access device via the print server. A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data. Authorization is provided from the intermediary service to the internet application to transmit the print data to the home access device via the print server. A notification is sent from the intermediary service to the print server that the intermediary has authorized the internet application to transmit the print data to the home access device. The print data is then transmitted from the internet application to the home access device via the print server for printing on the printer.” column 4, lines 10-31).*

**Regarding claim 5;** Gacek ‘205 discloses wherein the document server further comprises a shop information storing unit that stores information relating to a shop where the image forming apparatus is installed, and the print data altering unit alters the contents of the print data to be sent to the image forming apparatus depending on the shop information (“As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6

*and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.” column 7, lines 47-62)*

**Regarding claim 8;** Gacek ‘205 discloses a document server which is so configured as to receive print data from a contents server providing various information including the print data, and to send the print data to an image forming apparatus which is installed remotely away from the document server but is communicatively connected therewith via the Internet, the document server comprising: (“...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via the remote print server for printing.” column 3, lines 52-63): a print data storing unit that stores print data sent from the contents server, and a document ID in association with the print data (“Preferably, CPSI server 312 controls access to printers of home users by accepting a print job addressed to a home user only if the print job is specifically allowed according to the

*preferences of the home user which are stored in preferences directory 21, or if CPSI server 312 has been instructed by an authenticated intermediary service to accept the print job.” column 12, lines 13-19); a print data retrieving unit that retrieves, from the print data storing unit, the print data in association with the document ID sent from the image forming apparatus (“As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user.” column 7, lines 47-62); an accounting unit that calculates a fee relating to printout of the print data retrieved by the print data retrieving unit (“A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data. Authorization is provided from the intermediary service to the internet application to transmit the print data to the home access device via the print server. A notification is sent from the intermediary service to the print server that the intermediary has authorized the internet application to transmit the print data to the home access device. The print data is then transmitted from the internet application to the home access device via the print server for printing on the printer.” column 4, lines 21-31); a payer judging*



unit that judges a payer of the fee relating to printout of the print data, based on the document ID (*"Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer."* column 4, lines 31-36); a data sending unit that sends the print data and the accounting data to the image forming apparatus (*"In particular, third-party merchant 102 sends a print job representing a financial statement via internet 101 and digital cable network 105 to the set-top box of home user 115 for printing on a printer of home user 115. This is referred to as "push -printing"."* column 6, lines 54-59); and a controlling unit that controls the data sending unit to send, to the image forming apparatus, the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the image forming apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer (*"...a method is provided for authorized transmission of print data from an internet application to a home access device having a printer connected thereto, the printer being serviced by a remote print server which controls data transmission to the home access device, wherein the method includes the steps of negotiating with an intermediary service to obtain authorization for the internet application to transmit the print data to the home access device via the remote print server, and transmitting, in the case that the authorization is obtained, the authorized print data from the internet application to the home access device via*

*the remote print server for printing on the printer. Preferably, authorization is obtained from an intermediary service for the internet application to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment is preferably transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer. By virtue of this arrangement, a method is provided whereby third-party-initiated print jobs to a specific home user can be blocked unless payment is provided by the initiating third party to compensate the home user for the ink and paper used during printing of the print job. In another embodiment of the invention, a method is provided for authorized transmission of print data from an internet application residing on a first network to a home access device residing on a second network, the home access device having a printer connected thereto, the second network having a print server which interfaces the first network to the second network and which controls data transmission to the home access device. Print data is generated by the internet application and an intermediary service is contacted to obtain authorization for the internet application to transmit the print data to the home access device via the print server. A payment amount is negotiated between the intermediary service and the internet application for the authorization to transmit the print data." column 3, lines 52-67 thru column 4, lines 1-22).*

Gacek '205 does not expressly disclose storing the fee as accounting data.

Lewis '565 discloses and storing the fee as accounting data ("*Electronic payments are reported to the transaction server 180 which then transmits them to a specified financial institution for deposit. Upon receipt back of an authorization code, transaction server 180 then*

*increments the user's descending register 21 in PSC 20n with the correct amount. The ascending and descending registers of each user 2n are stored on the Master Server 300 at RSP 4. Under current Postal Service guidelines, the total maximum amount permitted in the descending register 21 is \$500.00, but any value could be used, as well as no limit at all.*" column 12, lines 21-30).

Gacek '205 and Lewis '565 are combinable because they are from same field of endeavor of network systems (*"The server has a network including a transaction server, a transaction database, a server authentication module, and a receipt generation module. An internet connection is used between the client and the server network."* Lewis '565, See *"Abstract"*).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network systems taught by Gacek '205 by adding a storing the fee as accounting data as taught by Lewis '565.

The motivation for doing so would have been because it would be advantageous to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (*"It is another object of the invention to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (e.g., increased efficiency in scheduling and delivery of packages and mail in electronic commerce that is secure and traceable)." Lewis '565 at column 2, lines 11-14).*

Therefore, it would have been obvious to combine Gacek '205 with Lewis '565 to obtain the invention as specified in claim 8.

**Regarding claim 9;** Gacek '205 discloses client data storing unit that stores data relating to clients therein, and the payer judging unit judges whether charging is necessary based on the client data (*"It can be appreciated that several different means can be utilized to tender the payment. For instance, third-party merchant may have a pre-existing account with intermediary service 305, whereupon the account is simply debited the amount of the payment. Instead, the payment could be directly billed by intermediary service 305 to third-party merchant 302. In another example, third-party merchant 302 may present credit card information to intermediary service 305 which is then verified and charged according to commonly known internet credit card techniques and services."* column 14, lines 22-32).

**Regarding claim 10;** Gacek '205 discloses a print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data (*"Preferably, CPSI server 312 controls access to printers of home users by accepting a print job addressed to a home user only if the print job is specifically allowed according to the preferences of the home user which are stored in preferences directory 21, or if CPSI server 312 has been instructed by an authenticated intermediary service to accept the print job. In the latter case, CPSI server 312 preferably allows acceptance of the authorized print job for only a limited amount of time from the receipt of the authenticated intermediary service's instructions, after which the print job will not be accepted by CPSI server 312. If third-party merchant 302 does not successfully negotiate with intermediary service 305 for authorization to push the print job to home user 320 (step S405), then flow passes to end (step S412) and the process is terminated."* column 12, lines 13-27).

**Regarding claim 12;** Gacek '205 discloses a shop information storing unit that stores information relating to a shop where the image forming apparatus is installed, wherein the print data altering unit alters the contents of the print data to be sent to the image forming apparatus depending on the shop information (*"As shown in FIG. 2, CHE 6 includes IPP server 19 for supporting IPP client 17, and also includes CPSI server 37 for supporting CPSI client 16. In this manner, a print job can be sent from internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 within CHE 6 and on to CPSI server 37. CHE 6 also includes preferences directory 21 which stores information about the preferences and printing abilities of home users who subscribe to the associated digital cable network, such as digital cable network 105. Also included in CHE 6 is CPSI spooler 20 which receives print jobs from CPSI server 37, creates logical printers corresponding to one or more printer(s) of the appropriate home user, and which creates queues for each logical printer in which print jobs are spooled for subsequent transmission to the corresponding a targeted printer of a home user."* column 7, lines 47-62).

5. **Claims 6, 11 & 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gacek '205 with Lewis '565 as applied to claim 1 above, and further in view of Lewis '565.

**Regarding claim 6;** Gacek '205 and Lewis '565 as modified does not expressly disclose wherein the controlling unit of the document server erases the document ID upon lapse of a predetermined period from the time when the document server receives the document ID from the contents server.

Lewis '565 discloses wherein the controlling unit of the document server erases the document ID upon lapse of a predetermined period from the time when the document server

receives the document ID from the contents server (*"The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate."* column 30, lines 43-50).

Gacek '205 and Lewis '565 are combinable with Lewis '565 because they are from same field of endeavor of network systems (*"The server has a network including a transaction server, a transaction database, a server authentication module, and a receipt generation module. An internet connection is used between the client and the server network."* Lewis '565, See *"Abstract"*).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network system as taught by Gacek '205 and Lewis '565 by adding wherein the controlling unit of the document server erases the document ID upon lapse of a predetermined period from the time when the document server receives the document ID from the contents server taught by Lewis '565.

The motivation for doing so would have been because it would be advantageous to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (*"It is another object of the invention to provide products for using electronic commerce payment technologies as well as new approaches to old challenges (e.g., increased efficiency in scheduling and delivery of packages and mail in electronic commerce that is secure and traceable)." Lewis '565 at column 2, lines 11-14).*

Therefore, it would have been obvious to combine Gacek '205 and Lewis '565 with Lewis '565 to obtain the invention as specified in claim 1.

**Regarding claim 11;** Lewis '565 discloses wherein the controlling unit restricts the number of transmissions of the print data identified by the document ID to the image forming apparatus when the document server receives the document ID from the image forming apparatus two or more number of times (*"The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate."* column 30, lines 43-50).

**Regarding claim 13;** Lewis '565 discloses wherein the controlling unit erases the document ID upon lapse of a predetermined period from the time when the document server receives the document ID from the contents server (*"The server 4 will validate the certificate for authenticity by first checking to ensure that the new CA certificates public key authenticates the included signature. It will then hash the keys included with the new certificate to verify that the hash value match with the old hash included with the old CA's certificate. If both conditions validate, the old CA's certificate is deleted and replaced with a new CA certificate."* column 30, lines 43-50).

6. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gacek '205 and Lewis '565 as applied to claim 1 above, and further in view of Tezuka et al. (US 6,018,769 hereinafter, Tezuka '769).

**Regarding claim 7;** Gacek '205 and Lewis '565 as modified does not expressly disclose wherein the contents server sends, to a communications terminal, a warning message indicating that the document ID will be erased upon lapse of the predetermined period, before the predetermined period lapses.

Tezuka '769 discloses wherein the contents server sends, to a communications terminal, a warning message indicating that the document ID will be erased upon lapse of the predetermined period, before the predetermined period lapses. (*"At step 3625, the module receives a message indicating that Erase (E) is selected from the edit menu of the system."* column 23, lines 10-11). See also Figure 36.

Gacek '205 and Lewis '565 are combinable with Tezuka '769 because they are from same field of endeavor of network systems (*"This invention relates to an integrated network installation system which aids in facilitating integrated installation of a network and more particularly to an integrated network installation system which displays a network block diagram on a display section for enabling the user to set the network configuration visually when installing a network."* Tezuka '769 at column 1, lines 13-18).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the network system as taught by Gacek '205 and Lewis '565 by adding wherein the contents server sends, to a communications terminal, a warning message indicating



that the document ID will be erased upon lapse of the predetermined period, before the predetermined period lapses as taught by Tezuka '769.

The motivation for doing so would have been because it would be advantageous to enable the operator to set network functions of information processors connected to the network as printers, clients, or servers while visually recognizing them (*"It is therefore an object of the invention to provide an integrated network installation system which can set installation parameters while simulating the network to be installed and more particularly to an integrated network installation system which enables the operator to set network functions of information processors connected to the network as printers, clients, or servers while visually recognizing them."* Tezuka '769 at column 2, lines 11-14).

Therefore, it would have been obvious to combine Gacek '205 and Lewis '565 with Tezuka '769 to obtain the invention as specified in claim 1.

### **Conclusion**

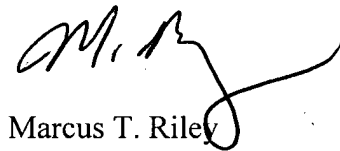
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus T. Riley whose telephone number is 571-270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

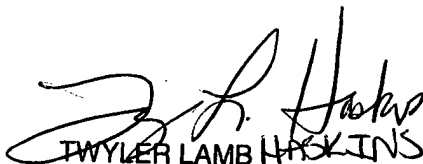
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